



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,058	11/29/2000	Benjamin N. Truelove	44431/233651 (JA2785)	8668

7590

03/25/2004

W. SCOTT PETTY
KING & SPADLING
191 PEACHTREE STREET, 45TH FLOOR
ATLANTA, GA 30303-1763

EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
----------	--------------

2178

6

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,058

Applicant(s)

TRUELOVE ET AL.

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the application filing, Application filed on 11/29/2000.
2. Claims 1-23 are pending in the case, claims 1, 13 and 22 are independent claims.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- "118a' & b' " on page 6, line 31.
- "120' " on page 6, line 33.
- "118" on page 7, line 11.
- "360" on page 11, line 13.

A proposed drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- "500" in Figure 5.
- "518" in Figure 5.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:

- The disclosure recites "*the method returns to step 510*" (page 16, line 8) in reference to Figure 5. Figure 5 shows that the method returns to step 508.
- The disclosure recites "*the method ends at step 516*" (page 16, line 25) in reference to Figure 5. Figure 5 shows that the method ends at step 518.
- The disclosure recites those reference signs listed in paragraph 3 above, which are not shown in the drawings.
- The disclosure fails to disclose those reference signs listed in paragraph 4 above, which are shown in the drawings.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

7. Claims 1, 3-9, and 11-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Russo Borland, "Running Microsoft Word 97", Published by Microsoft Press, Redmond, Washington USA, 1997. "*Russo Borland*" is hereafter referred to as "*Borland*".

8. **In regard to independent claim 1**, the first limitation of the claim is directed toward determining a sample of formats comprising a plurality of formats form a format set. Borland discloses the use of format "Styles" in the figure on page 60. The figure discloses a plurality of formats and related samples.

The second limitation of the claim is directed toward identifying a portion of text to be reformatted. Borland recites: "*To simply have Word apply a format to your document quickly after you're done adding text, set an insertion point in the document (or select a portion of the document if you want to decorate only that portion)*" (page 37, second paragraph).

The third limitation of the claim is directed toward reformatting the text and displaying the result in a preview window. Borland discloses reformatted text in a preview window in the figure on page 61.

9. **In regard to dependent claim 3**, the claim is directed toward selecting a color and font that determines a format set. Borland discloses selecting fonts and colors in the first figure on page 43. The user would select the "Ok" button in the dialog window shown in the first figure on page 43 to determine the selected format set.
10. **In regard to dependent claims 4 and 5**, the claims are directed toward a trained designer defining color schemes (claim 4) and font themes (claim 5). Borland discloses a "*Hiring a Decorator: AutoFormat*" section of his manual, starting on page 35 (second paragraph). Borland also recites: "*Improving the looks of characters means adding decorative touches to the basic appearance of words—selecting the font name, style, size, and colors*" (page 42, second paragraph).
11. **In regard to dependent claim 6**, the claim is directed toward format having a font name, font color and font size. Borland discloses font name, color and size in the first figure on page 43.
12. **In regard to dependent claim 7**, the claim is directed toward a preview window displayed above the document. Borland discloses a preview window dialog box in the figure on page 61. Window's Dialog boxes are displayed above the parent application (in this case the Word document).

13. **In regard to dependent claim 8**, the first limitation of the claim is directed toward receiving a command to add a custom format. Borland discloses adding a new format in the figure on page 60 (see the “New” button shown in the figure).

The second limitation of the claim is directed toward adding the custom format to the sample of formats. Borland describes the steps to add a custom format (described as “Styles”) on pages 826 to 842. Specifically the dialog box on page 830 (the upper figure on the page) shows the basic custom font-specifying tool, where the user would select the “Ok” button to add the custom format to the sample of formats.

The third limitation of the claim is directed toward reformatting the text with the custom format and displaying the reformatted text in the preview window. Borland discloses a custom format (shown as “Invite”) used to reformat a section of text, which is displayed in a preview window in the figure on page 834.

14. **In regard to dependent claim 9**, the claim is directed toward a user defined custom format. Borland describes the steps for a user to add a custom format (described as “Styles”) on pages 826 to 842.

15. **In regard to dependent claims 11 and 12**, the claims are directed toward identifying the portion of text to be reformatted by text located adjacent to the cursor (claim 11) or text that has been highlighted (claim 12). Borland recites: “*To simply have Word apply a format to your document quickly after you're done adding text,*

set an insertion point in the document (or select a portion of the document if you want to decorate only that portion)" (page 37, second paragraph).

16. **In regard to independent claim 13**, the claim is directed to a system for performing the method of claims 1 and 3 combined, and is rejected with the same rationale.
17. **In regard to dependent claim 14**, the claim is directed to a system for performing the method of claim 6, and is rejected with the same rationale.
18. **In regard to dependent claim 15**, the claim is directed to a system for performing the method of claim 4, and is rejected with the same rationale.
19. **In regard to dependent claim 16**, the claim is directed to a system for performing the method of claim 5, and is rejected with the same rationale.
20. **In regard to dependent claim 17**, the claim is directed to a system for performing the method of claim 7, and is rejected with the same rationale.
21. **In regard to dependent claim 18**, the claim is directed to a system for performing the method of claim 8, and is rejected with the same rationale.
22. **In regard to dependent claim 19**, the claim is directed to a system for performing the method of claim 9, and is rejected with the same rationale.
23. **In regard to dependent claim 20**, the claim is directed to a system for performing the method of claim 11, and is rejected with the same rationale.

24. **In regard to dependent claim 21**, the claim is directed to a system for performing the method of claim 12, and is rejected with the same rationale.
25. **In regard to independent claim 22**, the claim is directed to a user interface for performing the method of claims 1 and 3 combined, and is rejected with the same rationale.
26. **In regard to dependent claim 23**, the claim is directed to a user interface for performing the method of claim 8, and is rejected with the same rationale.

Claim Rejections - 35 USC § 103

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- “(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”
28. Claims 2 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Borland.
29. **In regard to dependent claims 2 and 10**, the claims are directed toward a computer readable medium with computer executable instructions. Borland discloses reformatting documents as described above. Borland fails to explicitly describe a computer readable medium with instructions, but Borland describes

Art Unit: 2178

common computer environment capabilities, like saving files (page 132), creating folders (page 133) and exiting applications (page 150).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to use the teachings of Borland on a computer system, because document format management is typically implemented on a computer system to allow instantaneous document reformatting capabilities.

Conclusion

30. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-5,689,724	11-1997	Morgan et al.
• US-5,859,648	01-1999	Moore et al.
• US-5,877,776	03-1999	Beaman et al.
• US-5,990,907	11-1999	Colletti, John C.
• US-6,073,147	06-2000	Chan et al.
• US-6,323,865	11-2001	Colletti, John C.
• US-6,330,577	12-2001	Kim, Hyun-Don
• US-6,456,385	09-2002	Rolling et al.
• US-6,675,358	01-2004	Kido, Akio

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone

Art Unit: 2178

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
March 18, 2004



STEPHEN S. HONG
PRIMARY EXAMINER